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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,393	07/18/2003	Kevin Conwell	13551	4619

7590

02/24/2006

ORUM & ROTH  
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CHICAGO, IL 60604

EXAMINER
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AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/623,393

Applicant(s)

CONWELL ET AL.

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-8 and 10-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-8 and 10-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Rejections withdrawn***

1. Claims 1, 4-8, 9-15 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Koops in view of Majumdar (6221453) in the last Office Action of august 17, 2005 has been withdrawn in view of the amendment filed on November 21, 2005.
2. Claims 15-21 and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Koops in view of Majumdar and further in view of Voeller (6822582) made in the last Office Action has been withdrawn in view of the amendment.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1, 4-8, 10-23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-8, 9-14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majumdar (6221453).

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Majumdar relates to a tire label comprising a barrier layer of polyester (col. 3, lines 41-44) coated on a first side with adhesive (col. 3, lines 23-26) and provided on the other side of the barrier is a facestock or top layer of polyester (col. 4, lines 1-4). The facestock or top layer has a thickness of 5-100 microns (col. 4, lines 10-12) which includes the claimed range of 0.001 to 0.008 inches. The label, as a whole, is preferably less than 250 microns thick (col. 4, lines 10-20) and this would include the thickness range of the adhesive layer. The barrier coating inhibits migration of mobile substances from an object (abstract). The label can be provided with print. Further, because the label is applicable to a tire wall, it would be inherently conformable. However, Majumdar fails to teach that the facestock film has a stiffness of 20-80 mg (Gurley). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Majumdar by providing its label facestock to have a stiffness of 20-80 mg (Gurley), based on optimization through routine experimentation, to exhibit optimum conformability

Further, because Majumdar does teach the preferred polyester as the top layer is polyethylene terephthalate and that it can also function as a barrier layer, therefore it would have been obvious to one having ordinary skill in the art to use polyethylene terephthalate as the barrier between the adhesive and the top layer.

Regarding claim 8, Majumdar discloses, in col. 3, lines 40-43, that the facesheet can be of polyester, polyethylene, polypropylene, etc. materials that are equivalent structures known in the art. Therefore, because these material were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it

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obvious to substitute polyethylene or polypropylene film as the top layer for the polyester film in Majumdar.

6. Claims 15-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majumdar in view of Tuttle (6375780).

Majumdar, as discussed above, fails to teach the presence of an RFID tag between the facestock and the barrier coating. Tuttle relates to an RFID tag located between a top and bottom polyester layers (col. 12, lines 55-60), wherein the top layer is taken to be the facestock and the bottom layer is interpreted to be the barrier layer. The lower surface of the bottom layer is provided with an adhesive layer (80). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Tuttle's teaching of providing an RFID tag between the top and bottom polyester layers in the invention of Majumdar with the motivation to provide protection to the RFID tag and identification of articles to which the tag is attached.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772  
2/21/06

N. Ahmad.  
February 21, 2006.